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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,632	10/17/2003	David Vincent Byrne	P69223US0	8911

7590 09/14/2004

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PROFESSIONAL LIMITED LIABILITY COMPANY  
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WASHINGTON, DC 20004

EXAMINER
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RHEE, JANE J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/686,632

Applicant(s)

BYRNE, DAVID VINCENT

Examiner

Jane Rhee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 9-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Rejections Withdrawn***

1. The 35 U.S.C. 102 (b) rejection of claims 1-4,6-18 anticipated by Clarke et al. has been withdrawn due to applicant's amendment in response 6/16/2004.
2. The U.S.C. 103 (a) rejection of claim 5 over Clarke et al. in view of Pellegrino et al. has been withdrawn due to applicant's amendment in response 6/16/2004.
3. The 35 U.S.C. 112 rejection of claim 9 has been withdrawn due to applicant's amendment in response 6/16/2004.

### ***New Rejections***

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4,12-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Clarke et al. (3426659).

Clarke et al. discloses a cover for extending over a trench (figure 1 number 12), the cover member comprising a pair of ground engaging portions (figure 1 number 34,33 and 11) bridged by a central trench covering portion (figure 1 number 14), and a trench element depending from the cover member to confine the cover member with respect to a trench (figure 1 number 26), the

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trench element being movable relative to the cover member between discrete locations to facilitate adjustment to a desired width of the trench (figure 1 number 26), wherein the trench elements comprises a plurality of openings (figure 1 number 27 and 22), and the cover member comprises a protrusion (figure 1 number 24) in connection with the cover member (figure 1 number 20 which is apart of cover member 12) and protruding from an underside of the cover member (figure 1 number 24) for engagement in one of the plurality of openings corresponding to one of the plurality of discrete locations (figure 1 number 24 and 22). Clarke et al. discloses at least two trench elements (figure 1 number 26 and 21). Clarke et al. discloses that the two trench elements are movable relative to the cover member between a number of discrete locations to facilitate adjustment to a desired width of trench (figure 1 number 26 and 21). Clarke et al. discloses that the cover comprises a lock to releasably lock a trench element in a desired position relative to the cover member (figure 1 number 29 and 24). Clarke et al. discloses that the lock means comprises a fixing pin extendable through an opening in the trench element (figure 1 number 24 and 22) and an aligned opening in the cover member (figure 1 number 24 and 20,19). Clarke et al. discloses a guide on the underside of the cover (figure 2 number 14). Clarke et al. discloses that the guide is defined by a pair of ribs depending from the underside of the cover, the ribs being spaced apart to received a portion of the trench element therebetween (figure 2 number 14 and 31). Clarke et al. discloses that the trench element comprises a handle portion to facilitate gripping of the trench element during adjustment (figure 1 number 21). Clarke et al.

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discloses that the trench elements are oppositely directed (figure 1 number 21 and 26). Clarke et al. discloses that the protrusion substantially fills a discrete hole in the trench element (figure 1 number 24). Clarke et al. discloses that the protrusion comprises an elongate extension for engagement in the slot in the trench element (figure 1 number 24). Clarke et al. discloses that the cover comprises an interlink arrangement comprising a first interlink part at one side of the cover member (figure 4 number 32, left side) and a complementary second interlink part at an opposite transverse side of the cover member (figure 4 number 32 right side), one of the first or second interlink part being engagable underneath the other of the first and second interlink part of a like cover on assembly (figure 3 number 13). Clarke et al. discloses that the cover is relatively movable with respect to an adjacent cover to follow the contour of a trench (col. 2 line 15-16). Clarke et al. discloses a cover assembly for a trench, the assembly comprising a plurality of covers (col. 2 lines 15-16).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke et al. in view of Wild (GB 2281928).

Clarke et al. discloses the trench cover described above. Clarke et al. fail to disclose that the plurality of openings on the trench element is interconnected to form an elongate slot and each of the plurality of the openings is an enlarged hole at discrete locations along the elongated slot. Wild teaches an elongated slot wherein a protrusion engages in the slot of the trench element (figure 1 number 22 and 30) for the purpose of obtaining a slidably engageable fastening means (page 3 lines 15-16). Wild fail to teach that the plurality of openings on the trench element is interconnected to form the elongated slot and that the openings are enlarged holes at discrete locations along the elongated slot. However, Wild teaches the equivalent function of applicant's slot formed from a plurality of enlarged openings which is to fasten the trench element to the cover by a protrusion (figure 1 number 12 trench, 14 cover, and 30 protrusion) therefore the difference between Wild and applicant's elongated slot formed from a plurality of enlarged holes is the shape of the slot.

A change in shape is generally recognized as being within the level of ordinary skill in the art, since such a modification would have involved a mere change in shape of a component and it would have been an obvious matter of design choice. In re Daily, 149 USPQ 47 (CCPA 1976). Thus, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Clarke et al. with an elongated slot in order to obtain a slidably engagable fastening means as taught by Wild (page 3 lines 15-16) and further to provide the elongated slot taught by Wild with a plurality of

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enlarged holes to change the shape of the component as a matter of design choice.

### ***Response to Arguments***

6. Applicant's arguments filed 6/16/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that Clarke et al. fail to teach all the features of the newly amended claim 1, Clarke et al. discloses a cover for extending over a trench (figure 1 number 12), the cover member comprising a pair of ground engaging portions (figure 1 number 34,33 and 11) bridged by a central trench covering portion (figure 1 number 14), and a trench element depending from the cover member to confine the cover member with respect to a trench (figure 1 number 26), the trench element being movable relative to the cover member between discrete locations to facilitate adjustment to a desired width of the trench (figure 1 number 26), wherein the trench elements comprises a plurality of openings (figure 1 number 27 and 22), and the cover member comprises a protrusion (figure 1 number 24) in connection with the cover member (figure 1 number 20 which is apart of cover member 12) and protruding from an underside of the cover member (figure 1 number 24) for engagement in one of the plurality of openings corresponding to one of the plurality of discrete locations (figure 1 number 24 and 22).

In response to applicant's argument of the 103 rejection of claim 5, this argument is moot in view of the new rejection of claim 5 described above.

### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F 9-6.

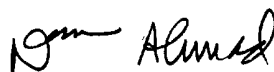
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).



Jane Rhee  
September 3, 2004

  
NASSER AHMAD  
PRIMARY EXAMINER 9/7/04